

Appln. No.: 09/010,919
Reply dated August 19, 2005
ORDISH et al.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Christopher J. ORDISH et al.

Serial No.: 09/010,919

Filed: January 23, 1998

For: **OFFER MATCHING SYSTEM**

Atty. Docket No.: 003432.73540

Group Art Unit: 3626

Examiner: A. Kalinowski

**REPLY TO NOTICE OF NON-RESPONSIVE COMMUNICATION TO
REQUIREMENT FOR INFORMATION
UNDER 37 C.F.R. §1.105**

AND INFORMATION DISCLOSURE STATEMENT

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Arlington, VA 22314

Sir:

In response to the Notice of Non-responsive Communication to Requirement For Information, which was mailed May 19, 2005, please enter the following remarks and information into the file of the above-captioned patent application.

Applicants respectfully request a two (2) month extension of time, up to and including August 19, 2005, to respond to the outstanding action in the above-referenced application.

It is believed that a fee of \$450 is required for the four-month extension of time. However, if the actual fee is more or less than this amount, please debit our Deposit Account No. 19-0733 for whatever fee is required.

Pursuant to 37 CFR §1.56 and in compliance with the Requirement For Information under 37 C.F.R. §1.105, Applicants submit herewith Form PTO SB/08 listing references for consideration in connection with the above-identified application. Applicants do not waive any right to take appropriate action to establish patentability over the listed documents should any of

them be applied as a reference against the claims of the present application.

Since this Information Disclosure Statement is being filed pursuant to a requirement for information, it is submitted that no fee beyond the two-month extension fee and no certification is required. However, if an additional fee is required, please charge our Deposit Account No. 19-0733.

The references submitted herewith and listed on the attached Form PTO SB/08 (the "IDS references") are press releases published in February and April 1992, which show that the Reuters' system known as Dealing 2000-2 underwent **public beta testing in early 2002**. As noted on page 2, fifth paragraph of the article entitled "Lead Story #2: Reuters' Dealing 2000-2 Beta Tests Near End Traders Approve, February Launch in Site?," beta tests previously scheduled for 1990 were **postponed**.

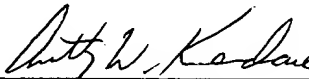
The Requirement For Information mailed May 19, 2005 relies upon an entitled "DEALING 2000-2 DELAYS, MARKET WORRIES HIT REUTERS' SHARES" dated September 14, 1990 (the "Delay article"). As noted therein on page 1, line 14, implementation of the Reuters' Dealing 2000-2 was rumored to be delayed as of September 14, 1990. As further noted on page 2, line 2-4, "[t]he TST report claimed that beta-testing of the Dealing 2000-2 service has been delayed following problems during **in-house** alpha-testing." Emphasis added. The Delay article further states, "client testing **will take place** when we are satisfied with the outcome of our own tests." *Id.* at lines 14 and 15.

The Delay article of 1990 clearly indicates that public beta testing planned for 1990 was postponed. The IDS references submitted herewith substantiate that beta testing of the Dealing 2000-2 system did not occur until 1992. Further, Applicant's noted in the response dated February 2, 2005 that "[t]he Dealing 2000-2 product is an anonymous, electronic price matching system for use by traders that **was launched in 1992**." Accordingly, Applicants respectfully submit that the Dealing 2000-2 system was not in public use in 1990 and was not beta tested in 1990, which is further substantiated by the Delay article itself and the IDS references submitted herewith.

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Applicants respectfully submit that the application is in condition for allowance over the prior art of record and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicant's undersigned representative at the below-listed number.

Respectfully Submitted,

By: 
Anthony W. Kandare
Registration No. 48,830

BANNER & WITCOFF, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001
(202) 824-3000

Dated: Aug. 19, 2005



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Christopher J. Ordish

Appln. No.: 09/010,919

Filed: January 23, 1998

For: OFFER MATCHING SYSTEM

Atty. Docket No.: 003432.73540

Group Art Unit: 3626

Examiner: A. Kalinowski

INFORMATION DISCLOSURE STATEMENT

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Arlington, VA 22314

Sir:

This Information Disclosure Statement is submitted for consideration by the United States Patent and Trademark Office in accordance with the duty of disclosure.

Transmitted herewith is:

- ☒ [X] PTO SB08 form
- ☐ [] A Background Art Information Paper
- ☒ [X] A copy of each item of information listed on the SB08 form excluding U.S. Patents and U.S. Patent publications
- ☐ [] Concise explanation of non-English language information
 - ☐ [] concise explanation of relevance:
 - ☐ [] English translation of foreign language information
 - ☐ [] English language version of foreign patent office report citing information
 - ☐ [] English language abstract(s) of foreign patent document(s)

U.S. Patent Application No. 09/010,919 to Christopher J. Ordish

- ☐ This application relies, under 35 U.S.C. §120, on the earlier filing date of U.S. Application Serial No. ****, filed ***. The information identified on the attached PTO 1449 form was submitted to and/or cited by the Patent and Trademark Office in this earlier application and, therefore, copies are not required to be provided in this application.

1. ☐ This Information Disclosure Statement is filed before the later of:
- ☐ three months from the filing date of this national application;
 - ☐ three months from the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; or
 - ☐ the mailing date of a first office action on the merits.

In accordance with 37 CFR 1.97(b), no fee is required.

2. ☒ This Information Disclosure Statement is filed after the events noted in paragraph 1, but before either:
- ☒ a final action under 37 CFR 1.113, or an action that otherwise closes prosecution,
 - ☐ a Notice of Allowance under 37 CFR 1.311.

In accordance with 37 CFR 1.97(c), also enclosed is

- ☐ a fee under 37 CFR 1.17(p) for \$180.00; or
 - ☐ a certification as stated below.
3. ☐ This Information Disclosure Statement is filed before payment of the issue fee, but after either
- ☐ a final action under 37 CFR 1.113, or an action that otherwise closes prosecution;
 - ☐ a Notice of Allowance under 37 CFR 1.311.

In accordance with 37 CFR 1.97(d), also enclosed is:

- ☐ a certification, as stated below; and
- ☐ the IDS processing fee set forth in 37 CFR 1.17(p)(1) in the amount of \$180.00.

Certification

The undersigned states:

☐ Each item of Information contained in this Information Disclosure Statement was cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing date of this Information Disclosure Statement; or

☐ The undersigned certifies under 37 C.F.R. § 1.704(d) that each item of information contained in this Information Disclosure Statement was cited in a communication from a foreign Patent Office in a counterpart application and that this communication was not received by any individual designated in 37 C.F.R. § 1.56(c) more than thirty days prior to the filing of this statement.

☐ No item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign Patent Office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing date of this Information Disclosure Statement.

TOTAL FEES: \$

☐ A check for the amount of the above indicated TOTAL FEES is attached.

☐ Please charge Deposit Account No. 19-0733 in the amount of \$180.00.

☐ A check for \$ is enclosed.

☒ No fee is required.

☒ Please charge or credit Deposit Account No. 19-0733 for any deficiency or overpayment associated with this Information Disclosure Statement.

A duplicate copy of this sheet is enclosed for accounting purposes.

Applicants do not waive any right to take appropriate action to establish patentability over the listed documents should any of them be applied as a reference against the claims of the present application.

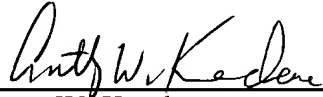
U.S. Patent Application No. 09/010,919 to Christopher J. Ordish

It is respectfully requested that the Examiner fully consider each item of information, initial the enclosed Form SB08 in the appropriate place to indicate that the information has been considered, and return a copy of the initialed form to the undersigned in accordance with MPEP Section 609.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: August 19, 2005

By: 
Anthony W. Kandare
Registration No. 48,830

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Washington, D.C. 20001-4597
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet	1	of	1
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Complete if Known

<i>Application Number</i>	09/010,919
<i>Filing Date</i>	January 23, 1998
<i>First Named Inventor</i>	Christopher J. Ordish
<i>Art Unit</i>	3626
<i>Examiner Name</i>	A. Kalinowski
<i>Attorney Docket Number</i>	003432.73540

[illegible]

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ - Number ⁴ - Kind Code ⁵ (if known)				

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials *	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		Factiva – Lead Story #2: Reuters' Dealing 2000-2 Beta Tests Near End Traders Approve, February Launch in Sight?, February 7, 1992, FX Week Waters Information Services Inc., Vol. 2, No. 34 ISSN: 1050-0782.	
		Factiva – Reuters Sets Launch Date For Foreign Exchange Matching System, April 16, 1992, Reuters News.	
		Factiva – It's Official! Reuters Set For Dealing 2000-2 Launch, April 24, 1992, Dealing with Technology Waters Information Services, Inc., Vol. 4, No. 8 ISSN: 0955-2138.	

Examiner
Signature

Date
Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language. Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2